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John Bruce Schelkopf IBM Corporation Legal Dept. Dept. 9CCA/Bldg.002-2 Research Triangle Park, NC 27709			SHIN, CHRISTOPHER B	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/756,831
Filing Date: January 08, 2001
Appellant(s): KARIDIS, JOHN PETER

MAILED

MAY 19 2004

Richard F. Frankeny
For Appellant

Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 25, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the appellant fails to separately argue between claims 1-10 and 11-14, respectively. In addition, appellant clearly stated that (page 17, lines 17-18) "Appellant asserts that the rejections of Claims 11-14 under 35 USC 103(a)

as being unpatentable over Trane is traversed for the same reasons as Claims 1-10."; this clearly contradicts with the appellant statements under Groupings of Claims. Furthermore, the appellant fails to argue separately for the 103 rejection under Trane in view of Saegusa. I.e., no separate arguments for claims 2-14 presented for this rejection.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,219,227	TRANE	4-2001
5,568,224	SAEGUSA	10-1996

(10) *Grounds of Rejection*

The following is the exact copy of the 103 rejection section of the Final Office Action.

Claim Rejections - 35 USC § 103

1. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trane (6,219,227).

1. In figures 1-3 & 6 and their respective description section of the Trane reference teaches all of the basic claimed limitations as follows:

Claims 1-10

Trane (6,219,227)

- a notebook computer with an I/O physical user interface
 - feature of figure 1 system
- base containing a keyboard for said notebook computer
 - feature of figure 1, (24)
- base has an extended portion beyond said keyboard creating a widened keyboard base

- feature of figure 1, widened portion (16)
- widened display having a widened I/O display area corresponding to said widened keyboard base
 - feature of figure 1, (14)
- widened display having a width substantially equal to a width of said widened keyboard base
 - feature of (14 & 24)
- I/O device area disposed within said extended portion of said widened keyboard base
 - feature of (16), figure 1
- interface signal connecting means mounted within said I/O device area, operable to couple signals from said notebook computer to an I/O device
 - feature of figures 3 & 6
- I/O device area, is recessed below a surface of the extended portion of said widened keyboard base, operable to receive said I/O device
 - obvious modification of feature of (46), figure 3
- interface signal connection means is disposed within said recessed I/O device area
 - feature of (54), figures 3 & 6, see columns 5-6, lines 44-13
- interface connection interposer (ICI) is disposed between said interface signal connection means and said I/O device, disposed within said recessed I/O device area
 - feature of figures 3 & 6
- (ICI) operable compensate for both mechanical and signal routing differences between said interface signal connection means, said recessed I/O area and said I/O device
 - feature of figures 3 & 6
- widened I/O display area is used to display operational data relative to operation of said I/O device when said I/O device is sending or receiving signals to said notebook computer
 - feature of columns 9-10, lines 43-6, figures 3 & 6
- first/second communication software instructions controlling communication between said notebook and said I/O device
 - feature of columns 9-10, lines 43-6, figures 3 & 6
- I/O device has functionality wholly separate from any communication signaling or connection with said notebook
 - feature of (48), figures 3 & 6

2. As for the claims 1& 3-10, the difference between the claimed invention and teachings of the Trane reference is that the reference does not identically or expressly teaches the claimed limitation "widened display". However, such limitation is an obvious design choice matter to one having ordinary skill in the art. This is because, the Trane reference teaches, in column 7, lines 27-35, the motivation of using any size display according the designer's choice. Therefore, it would have been obvious at the time the invention was made to

one having ordinary skill in the art to come up with the claimed invention for the reasons stated above, since all of the basic limitations and the motivation are disclosed by the Trane reference.

3. As per claim 2, further limits the location of the I/O device to be extended portion rather than vertical portion; however, such location is an obvious design matter. One skilled in the art can simply choose to utilize any sections/portions of the keyboard base surface. Besides, there are only four sizes to utilize; the either of horizontal sections of the base surface are already being used by printer and paper tray, and the bottom vertical side is taken up by pointing device. As a result, it is only obvious to use only remaining top vertical side, unless the designer simply choose to differently arrange/locate the device.

4. As for the claims 11-14, due to the similarity between the claims 1-10 & the claims 11-14 are not patentably distinctive from claims 1-10, the teachings of the claims 1-10 are similarly applied.

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trane (6,219,227) in view of Saeguse (5,568,224).

1. The teachings of Trane on claims 1-14 are similarly applied (see above for the teachings/rejection details

2. As can be seen from the Saeguse reference, column 2, lines 51-53, teaches "notebook 3 is capable of wide screen display based on a dot LCD and incorporates a communication function. This is another/additional more specific support/evidence of the examiner's 103 motivation "obvious design choice" rationale. As can be seen above from the teachings of Trane, the Trane reference teaches the motivation to use any size/type of display and the Saeguse specifically teaches wide screen display on a notebook that was well known at the time of the invention. It would have been obvious at the time the invention was made to one having ordinary skill in the art to combine the Trane & Saeguse references to come up with the invention for the reasons state above.

(11) Response to Argument

Before the examiner responses to the details of the appellant's arguments presented on pages 4-19 of the Brief, the examiner would like to point out that:

- 1) The appellant fails to properly argue, why it was not obvious to come up with the invention, throughout presented arguments on page 4-19;
- 2) The appellant allegedly argues that claimed features are not taught by the prior art of record without any support; and
- 3) The claimed terms "widened" & "corresponding" are not clearly and appropriately defined in the specification in terms of sizes and proportions in order to support applicant's arguments and interpretations of the claims; therefore, the broad interpretation is given to the claimed recitation "widened" & "corresponding". The examiner believes that the terms "widened" & "corresponding" are too broad to support the appellant's argument; the claimed "widened keyboard", "widened display" and "corresponding" terms used as an ADJECTIVE to describe a SIZE rather than a PROPORTION of the keyboard, display and the correspondence between them. Therefore, the examiner's interpretations of the "widened keyboard" and "widened display" are "wide keyboard" & "wide display", respectively. The examiner repeatedly tried to clarify the differences in the above interpretations between the examiner and the appellant, but the appellant did not cooperate to amend or make the record clear before filing to the Board. See the Advisory Action/Interview Summary (paper 8).

- Appellant's Arguments
 - Examiner's Response
- *Page 4, last 3 lines, the appellant allegedly argues that "Trane does not teach any specific relationship between the keyboard base, the keyboard, or the cellular telephone inserted into the keyboard base"*
 - This is not correct; Trane clearly teaches, in detail, the relationship between the keyboard base, the keyboard and the cellular telephone into the keyboard base.
Columns 1-9 clearly teach functional, structural and operational relationships between the keyboard base, the keyboard and cellular telephone.
- *Page 5, lines 4-5, Trane does not teach any correspondence between the widened display keyboard base and the display device. In lines 13-14, Trane does not teach or suggest +any correspondence between the display device in the lid and the keyboard base.*
 - This is not correct, Trane clearly teaches a correspondence that reads on the claimed invention. As can be seen from the claim 1, it recites, "**substantially equal**" between the widened keyboard base and the display device. In figure 2, Trane teaches one to one correspondence between the widened keyboard base (12) and the matching display (14). As can be seen from

the figure 2, the dimension of the display “substantially equal” or corresponds to the widened keyboard.

- *On pages 5 (line 15) – 6 (line 12), appellant argues that the Trane does not teach or suggest the teachings of the claim 7 limitations by the “LCD monitoring display”*
 - The examiner would like to make a clarification that the appellant misunderstood the examiner’s final office action. As can be seen from the final office action, page 4, lines 16-18, it clearly explained that the feature of Trane, columns 9 (line 43)-10 (line 6), which teaches the limitations of claim 7. As can be seen from Trane, column 9, lines 56-61, clearly teaches the limitations of the claim 7. Trane clearly teaches, "present invention further includes customized or conventional software to handle telephone messaging, facsimiles, internet connections, etc. Also the software can control the switching/setting between the regular telephone lines and the cellular telephone, as needed." This means that the portable computer uses customized or conventional software for facsimiles or internet connection, which reads on the limitations of the claim 7. This is because, it is not only well known, but also commonly practiced in the art to display a status & control icons on the display

(e.g., usually the right bottom corner of the display). For example, commonly known operating systems like Microsoft Window or Apple commonly perform such function/limitation. Almost all of notebook computer sold in retail store in U.S. come with such operating system. Therefore, the teachings of the Trane reference clearly read on the limitations of the claim 7.

- *On pages 6 (line 13)-7 (first paragraph), the appellant argues more about how the “widened” and “corresponding” limitations are defined and interpreted by the appellant.*
 - The examiner strongly traverses such argument; the claimed “widened” and “corresponding” limitations are not clearly defined in the specification to overcome the teachings of the prior art & support the appellant's arguments. For example, SIZE or PROPORTION have ~~not~~ been defined or discussed in the specification to overcome the teachings of the prior art.
- *On page 7 (first paragraph) – 8 (line 12), the appellant argues, as in claims 4-6, the claimed “interface connection interposer is disposed between the interface signal connection means” are not taught by the Trane reference and the improper interpretation is used by the examiner.*

- The examiner traverses such argument; as can be seen from the teachings of Trane, in figure 3, (46, 56 & 58), represents the equivalent limitations of the claimed interposer of the claims 4-6. As recited in claims 4-5, the combination of (46, 56, & 58), being part of the I/O device area (46), disposed between (16) & (54) and also disposed within (46). In addition, as in claim 6, the combination (46, 56 & 58) also teaches the compensation for both mechanical and signal routing differences between (16) and (54). Obviously, there are clearly mechanical & signal differences between (16) and (54) in order to use (16) as a means for facsimiles & internet connections, and clearly such differences are properly compensated by (46, 56 & 58). Not only that, the claimed compensation function is a necessary part of function of the Trane system of figure 3. See column 5 (line 64) – column 6 (line 12) for the above discussion details.
- *On page 8 (line 13) – 11 (end), the appellant basically argued that the Trane reference does not teach or suggest limitations regarding the “widened”; therefore, *prima facie has not been established.**

- The examiner strongly traverses such length arguments without support. As can be seen from the specification, no clear definition or support was given to “widened”. Therefore, the examiner gives a dictionary definition “to make or become wide or wider” (Webster II dictionary used). Given the dictionary definition, the teachings of the Trane reference clearly establishes the *prima facie*. In addition, the appellant's arguments are not supported by the claims, due to the insufficient support from the specification.
- *On page 12 (1st paragraph), the appellant argues that Trane does not teach or suggest the limitations of claim 2 based on the arguments of claim 1.*
 - The examiner strongly traverses such argument. As can be seen from the figure 3 of Trane, the I/O device area (46) is recessed below a surface a surface of the extended portion (see figure 2, extended/top portion of the keyboard) of the widened keyboard base (12), said recessed I/O device area (46) operable to receive said I/O device (16).
- *On page 12 (2nd paragraph) – 13 (first paragraph), the appellant argues that Trane does not teach or suggest the limitations of claim 3. First argument, the appellant*

argues that “communications device” is “not an I/O device”; Second argument, (46) is not in an extended portion; and Third, the examiner used impermissible hindsight.

- The examiner strongly traverses above arguments. As for the First argument, as can be seen from column 9, lines 56-61, Trane uses cellular phone (16) as a means to communicate with Internet connections, which is a definition of an “I/O device”. As for the Second argument, Trane teaches (46) located in the horizontal extended portion or keyboard (figure 2), which reads on the claimed invention. As for the Third argument, the examiner based the 103 rejections solely based on the prior art teachings, which clearly follows the guidelines of “permissible hindsight”; in addition, the appellant provides no support for the “impermissible hindsight” argument. The figure 2 of Trane clearly teaches all the limitations of claim 3.

- *Page 13 (2nd paragraph) – 14 (3rd paragraph), the appellant repeatedly argues about the limitations of the claim 4 not being taught by the Trane reference.*
 - The examiner again traverse such argument based on the interpretations of the interposer according to the specification. The specification does not clearly define the meaning of the interposer other than the functional

meaning of the claim. The appellant's argument is not supported by, or defined in, the specification. As can be seen from the teachings of Trane in figure 3, (46, 56 & 58) represents the equivalent limitations of the claimed interposer of the claims 4-6. As recited in claims 4-5, the combination of (46, 56, & 58), being part of the I/O device area (46), disposed between (16) & (54) and also disposed within (46). In addition, as in claim 6, the combination (46, 56 & 58) also teaches the compensation for both mechanical and signal routing differences between (16) and (54). Obviously, there are mechanical & signal differences between (16) and (54) in order to use (16) as a means for facsimiles/internet (see column 9, lines 56-60) connections, and clearly, such differences are properly compensated by (46, 56 & 58). Not only that, the claimed compensation function is a necessary/required part of the function of the Trane system of figure 3. See column 5 (line 64) – column 6 (line 12) for the above discussion details.

- *Page 14 (last paragraph) – 15 (1st paragraph), the appellant repeatedly argued that the Trane reference does not teach or suggest the limitations of claim 7.*

- The examiner would like to make a clarification that the appellant misunderstood the examiner's final office action. As can be seen from the page 4, lines 16-18, the examiner clearly explained that the feature of columns 9 (line 43)-10 (line 6) teaches the limitations of claim 7. As can be seen from column 9, lines 56-61, clearly teaches the limitations of the claim 7. Trane clearly teaches, "present invention further includes customized or conventional software to handle telephone messaging, facsimiles, internet connections, etc. Also the software can control the switching/setting between the regular telephone lines and the cellular telephone, as needed." This means that the portable computer uses customized or conventional software for facsimiles or internet connection, which reads on the limitations of the claim 7. This is because, it is not only well known but also commonly practiced in the art to display a status & control icons on the display (e.g., usually the right bottom corner of the display). For example, commonly known operating systems like Microsoft Window or Apple commonly perform such function/limitation. Almost all of notebook computer sold in retail store in U.S. come with

such operating system. Therefore, the teachings of the Trane reference clearly read on the limitations of the claim 7.

- *Page 15, last paragraph, the appellant argued that the limitations of claims 8-9 are not taught by the Trane reference.*
 - The examiner strongly traverses such arguments. As can be seen from the Trane reference, column 9, lines 56-60, the Trane clearly teaches “software to handle telephone messaging, facsimiles, internet connections, etc.. Also, the software can control the switching/setting between the regular telephone lines and the cellular telephone, as needed.” This means that there are at least two or more software to control communication between the cell phone to communicate with internet and the land telephone line to communicate with internet; in addition, Trane also teaches handling and switching between facsimiles via the cellular phone and the land telephone line. This clearly reads on the limitations of claims 8-9.
- *Page 16 (line 3) –17 (line 7), the appellant argues that Trane does not teach the invention of claim 10.*

- Trane clearly teaches cell phone (48) has functionality wholly separate from any communication signaling or connection with said notebook computer, on its own (i.e., when the cell phone is used as the cell phone by itself). Clearly, the cell phone by itself teaches the limitation of the claim 10.
- *Page 17 (lines 8-18), the appellant argues that the rejection claims 11-14 are traversed for the same reason as the claims 1-10.*
 - The appellant's argument contradicts the appellant's "GROUPING OF CLAIMS" states "Claims 1-14 are to be considered individually per the reasons set forth in Section VIII". Appellant failed to establish why the claims 1-10 and 11-14 are stand or fall together. Appellant entirely relied on the arguments of claims 1-10 for the claims 11-14. In addition, the above detailed examiner's response to arguments for the claims 1-10 are similarly applied.
- *Page 17 (line 19) – end, the appellant basically and generally presents arguments that were present earlier.*
 - The examiner strongly traverse the applicant's arguments for the Trane in view of Saegusa for the following reasons:

Firstly, the appellant fails to fully argue each and every claim separately, nor address the issues of the dependent claims 2-14.

Secondly, appellant contradicts the appellant's "GROUPING OF CLAIMS" statement; appellant stated "Claims 1-14 are to be considered individually per the reasons set forth in Section VIII". There are no mentioning of claims 2-10 and 11-14.

Thirdly, appellant's arguments are not supported by the claims in view of the specification. The appellant is giving a specific meaning to the "widened display". In addition, the Trane reference clearly motivates to use (e.g., column 7, lines 28-35) - "the display device 14 can be of any size, a person skilled in the art will understand that any type and size of display device 14, i.e., any commercially available display device or custom designed display device, can be incorporated into the portable computer assembly 10 of the present invention". This clearly supports the examiner's 103 rational, and the Trane reference recommends a designer to use or choose different types of the displays .

Fourthly, as can be seen from the Trans reference, the Trane reference clearly motivates to use any available and

custom designed display; in addition, Saegusa, further motivates to use a specific wide screen type. Therefore, the combination of Trane & Saegusa references clearly supports the examiner position.

Fifthly, the appellant's arguments seem to ignore common design practice of commercially available notebook/laptop.

One skill in the art knows that the almost all of the notebook/laptop sold in U.S. have the same basic form factor with a **relationship** between the keyboard portion (bottom casing) and the display portion (top casing); the top & bottom portions have a **relationship of being the same size** (vertical and horizontal dimension). This means that when a designer chooses a widened display, it is logical to choose the same sized keyboard/bottom casing.

Consequently, Trane's motivation of using a wide/widen display automatically applies to use a wide/widen keyboard.

The relationship between the display section and the keyboard section is inseparable one.

Finally, the appellant's arguments are mostly based on the appellant given meaning of "widened" and "corresponding"; however, such appellant given meaning are not supported

by the specification or the claims. The specification fails to define and support the specific arguments of the appellant.

Summary

The arguments present by the appellant are almost entirely hinges on the interpretations of the claimed "widened keyboard", "widened display" and "corresponding"; whether proper interpretations have been given to the claimed "widened keyboard", "widened display" and "corresponding". The examiner strongly believes that the specification fails to clearly define the meaning of the claimed "widened keyboard", "widened display" and "corresponding". Furthermore, the claimed terms "widened keyboard", "widened display" and "corresponding" are not commonly known terminology in the art of notebook computer. The claimed "widened keyboard", "widened display" and "corresponding" terms are used as ADJECTIVE to describe SIZE rather than PROPORTION (horizontal size vs. vertical size) of the keyboard, display and the correspondence between them. The examiner's interpretations of the "widened keyboard" and "widened display" are "wide keyboard" & "wide display", respectively. Given that interpretations, the examiner has strongly believes the claimed invention is not patentable over the Trane reference alone, and Trane reference in view of Saegusa, as in the Final Office Action.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner
Of 2182

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May 14, 2004

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